

REMARKS

The Applicants have now had an opportunity to carefully consider the comments set forth in the Office Action mailed August 9, 2006. All of the rejections are respectfully traversed. Amendment, reexamination and reconsideration of the application in view of the following remarks are respectfully requested.

The Office Action

In the Office Action mailed August 9, 2006:

a response to the arguments presented in Applicants' Amendment C was provided;

claims 1, 3, 6, 7, 12-15 and 17-20 (17-18?) were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,501,556 to Nishii ("Nishii");

claims 20 and 21 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,550,614 to Motoyama ("Motoyama");

claims 2 and 11 were rejected under 103(a) as being unpatentable over Nishii in view of Japanese Publication No. 07-307827 by Nakajima Toru ("Toru"); and

claims 9 and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nishii in view of Motoyama.

Reply to Response to Arguments

The --Response to Arguments-- addresses some of the arguments presented in Applicants' Amendment C. However, the present Office Action does not address at least some of the arguments presented by the Applicants including, for example, at least some of the arguments presented by the Applicants related to the lack of motivation in the prior art to combine the references and the inadequacies of alleged motivations asserted by the Office.

Additionally, the Applicants disagree with a number of the points submitted by the Office in the --Response to Arguments--. Accordingly, reconsideration in light of the following comments is respectfully requested.

Section 3 of the --Response to Arguments-- asserts that "Nishii teaches that the trial print mode is used to check for blank pages and then the print job is printed" and "this means if the blank page is removed in the trial mode, then a blank page

will not be printed in the main job.”

However, it is respectfully submitted that this assertion is in error. Nishii mentions a “normal print mode” (e.g., see line 1 of the Abstract) and discloses a “trial print mode” (e.g., Abstract, lines 3-4). Accordingly, it is respectfully submitted that the trial print mode and the “normal print mode” of Nishii are not the same. Nishii discusses removing a blank page in a trial print mode. However, Nishii does not disclose or suggest removing a blank page in the “normal print mode” or from a main job output. Column 2, lines 26-28 and 48-50, cited by the --Response to Arguments-- are both in regard to the trial print mode. Indeed, column 2, lines 26-28, recite “wherein in the **trial print mode**, an image corresponding to the blank page detector is not formed on the recording medium.” Column 2, lines 48-50, recite “In this embodiment, a user can check the position of the blank pages without outputting the blank page by checking the page numbers.” It is respectfully submitted that this cited statement is in regard to the minified images derived from the minified image data of the **trial mode** (column 2, lines 43-46).

Column 5, lines 14-26, also cited by the --Response to Arguments-- is also directed toward aspects of **trial printing**. Indeed, column 5, lines 20-26, recite “if an instruction of performing **trial printing** has been set by a command from the PC 1 or by the trial print mode key 4 of the control panel 3, and if a blank page is detected by the blank page detector 10, the interpreting section 9 processes the blank page in accordance with a relevant command from the PC 1 or the setting of the blank page output mode key 5.”

Nishii simply does not disclose or suggest removing blank pages from **main print job** image input data.

With regard to Toru, the --Response to Arguments-- asserts that Toru is not relied upon to teach removing individual portions of the main job output or image data. In this regard, it is respectfully submitted that the remarks of the Applicants were directed at pointing out that Toru could not be relied upon for such disclosure.

With regard to Motoyama, the --Response to Arguments-- asserts that Motoyama “taught that blank pages can be detected and aborted.”

However, it is respectfully submitted that Motoyama does not disclose or suggest aborting blank pages. Column 2, lines 1-10, cited by the --Response to Arguments--, discusses detecting blank pages at the beginning of a job and aborting

the entire job. That is, the cited portion of column 2 recites "It is, therefore, an object of the present invention to provide a blank page distinguishing and detection system and method that can detect an incorrectly placed reproduction job in an automatic document feeder (multiple initial blank pages in a reproduction job) and abort it, but can also permit a blank page within the middle of a reproduction to print normally."

It is respectfully submitted that Motoyama does not disclose or suggest removing blank pages from image input data. Indeed, Motoyama teaches away from doing so. Motoyama discusses distinguishing proper blank pages within a reproduction job and to abort the reproduction job if improper blank pages are detected (column 2, lines 5-8; lines 45-46). Accordingly, it is respectfully submitted that Motoyama does not disclose or suggest the subject matter for which it is relied. The present application does not claim distinguishing between blank pages.

Furthermore, since Motoyama characterizes blank pages within a production job as proper (column 2, lines 14-15), one that considers blank pages within a reproduction job to be improper and to be removed would not look to Motoyama. Accordingly, it would not be obvious to combine subject matter from Motoyama with any other reference in order to solve the problem of unwanted or improper blank pages within a production job. Therefore, it is respectfully submitted that Motoyama is not fairly combined with any reference against the claims of the present application.

With regard to **claim 3**, the --Response to Arguments-- makes some assertions with regard to a printer which does not operate until a command is given. However, it is unclear toward which printer or which reference this statement is directed. In any event, it is respectfully submitted that disclosure of a printer not operating until a command is given does not disclose or suggest a system requesting permission to perform an operation. Moreover, such disclosure does not disclose or suggest requesting permission from a user to remove an identified page.

With regard to **claim 7**, the --Response to Arguments-- asserts that "a non-blank sheet and a blank sheet are one and the same, therefore a blank page output would describe a non-blank separator sheet." However, it is respectfully submitted that one of ordinary skill in the art would understand that a non-blank sheet is a sheet that is not blank. Furthermore, it is respectfully submitted that a sheet that is not blank and a blank sheet are not one and the same. Additionally, **claim 7** has

been amended to correct antecedence and recites describing a characteristic of a non-blank separator sheet. It is respectfully submitted that Nishii does not disclose or suggest the existence of non-blank separator sheets. Accordingly, Nishii cannot anticipate or suggest establishing a characteristic of a non-blank separator sheet, monitoring the input stream to detect data representative of the characteristic of the non-blank separator sheet, identifying one or more pages that contain data representative of the characteristic of the non-blank separator sheet and removing the identified pages thereby excluding them from a main print job output stream. Nishii does not disclose or suggest removing pages from a main job output stream. Furthermore, Nishii only suggests removing blank pages (not non-blank pages) **from a trial mode output**.

With regard to **claim 20**, the --Response to Arguments-- again asserts that the "trial mode" of Nishii is used to delete blank pages from the main job output data. However, it is respectfully submitted that the --Response to Arguments-- does not identify any part of Nishii that discloses or suggests that blank pages are deleted for the main job output data. Instead, the cited portions of column 2 and column 5 are in regard only to a "trial mode."

Regarding **claims 2, 9, 11 and 19**, the -- Response to Arguments-- merely indicates that the Examiner disagrees with the Applicants and directs the attention of the Applicants to the earlier discussion of Toru. However, the earlier discussion of Toru indicates that Toru "is relied upon to teach of notifying an operator that an unwanted portion has been located." However, Toru does not disclose or suggest notifying an operator that an unwanted portion has been located. Instead, Toru notifies a user of "whether reading of the manuscript was normally performed immediately after reading the manuscript of one sheet in any case. When it is judged that there is no contrast, a user performs adjustment of reading sensibility, etc. and reads again." (paragraph 13) This does not disclose notifying an operator that an unwanted portion is located. Instead, Toru notifies the user that invalid data has been detected (Abstract). Accordingly, Toru does not include the subject matter for which it is relied. Even if the invalid data is a blank page, the notification is of invalid data and not an unwanted portion. Since Toru does not disclose the subject matter for which it is relied, **claims 2, 9, 11 and 19** cannot be obvious in light of combinations of references that rely on Toru for disclosure of notifying a user of a

detected unwanted portion.

With regard to **claims 9 and 13**, the --Response to Arguments-- asserts that the image data signal (126) of Motoyama can be understood to be instructions or a phrase. However, column 5, lines 64-67, of Motoyama, merely indicate that “the IMAGEDATA signal 126 contains electrical signals representing the optical characteristics of a page that are used by the detection system 118 to detect and distinguish blank pages in a reproduction job.” Motoyama does not disclose or suggest using pattern recognition techniques to search for matching characteristics as recited in **claim 9** or a pattern detector operative to receive an arbitrary description of an unwanted portion of the main print job input image data, search for a portion of the main print job input image data that corresponds to the unwanted portion description and relate information about a found portion that corresponds to the description, as recited in **claim 13**. The system of Motoyama searches only for blank pages and Motoyama does not disclose or suggest searching for any other matching arbitrary description. Accordingly, **claims 9 and 13** are not obvious in light of Motoyama.

The Claims are not Anticipated

Claims 1, 3, 6, 7, 12-15 and 17-20 were rejected under 35 U.S.C. 102(e) as being anticipated by Nishii.

However, **claim 1** recites a method operative to automatically exclude an unwanted page in an input stream of a printing system main print job from an output job of the main print job, the method comprising *inter alia*: removing the identified pages thereby excluding them from the main print job output stream.

Even if the assertions of the Office Action with regard to the disclosure of Nishii are correct, the techniques of Nishii are only operative in a “trial print mode” in regard to “minified images.” It is respectfully submitted that Nishii does not disclose or suggest removing or excluding blank or other unwanted pages from an input stream of a printing system main print job from an output stream of the main print job.

For at least the foregoing reasons, **claim 1**, as well as **claims 2, 3 and 7**, which depend therefrom, is not anticipated and are not obvious in light of Nishii.

Regarding **claim 3**, the Office Action asserts that Nishii teaches that the

printer receives commands from a user. However, **claim 3** recites requesting permission from a user. It is respectfully submitted that generic disclosure of a printer receiving commands does not disclose or suggest requesting permission from a user.

For at least the foregoing additional reasons, **claim 3** is not anticipated by Nishii.

Claim 6 was canceled in Applicants' Amendment B.

Claim 7 has been amended to correct antecedence.

Regarding **claim 7**, the Office Action asserts that Nishii discloses a blank page output mode and that this reads on describing characteristics of a non-blank separator sheet. However, it is respectfully submitted that Nishii is silent with regard to separator sheets. Moreover, it is respectfully submitted that disclosure of a blank page output mode does not disclose or suggest describing characteristics of a non-blank separator sheet. Blank pages and non-blank pages are not the same and Nishii does not anticipate describing or removing non-blank pages based on a description of unwanted non-blank pages.

For at least the foregoing additional reasons, **claim 7** is not anticipated by Nishii.

Claim 12 recites a method operative to automatically exclude unwanted portions of a main job from a main job output stream of a printing system, the method comprising *inter alia*: locating a portion of the main job input data that has the described characteristics, deleting the located portion from the main job input data to generate main job output data and delivering the main job output data to the output stream. Arguments similar to those submitted in support of **claim 1** are submitted in support of **claim 12**. Nishii is concerned with a **trial print mode** in which the input image data are processed into minified images on fewer pages of paper for **trial** output (Abstract). As such, Nishii does not disclose or suggest automatically excluding unwanted portions of a main job from a main job output stream of a printing system or deleting the located portion from a main job input data to generate main job output data.

For at least the foregoing reasons, **claim 12** is not anticipated by Nishii.

Claim 13 recites a printing system operative to automatically remove unwanted portions of main print job input image data, the printing system comprising

a pattern detector operative to receive an arbitrary description of an unwanted portion of the main print job input image data, search for a portion of the main print job input image data that corresponds to the unwanted portion description, and relate information about a found portion that corresponds to the description, and a portion deleter operative to receive information from the pattern detector regarding a location of the at least one unwanted portion of the main print job input image data and to remove the at least one unwanted portion of the main print job input image data to generate main print job output image data.

In this regard, arguments similar to those submitted in support of **claims 1 and 12** are submitted in support of **claim 13**.

For at least the foregoing reasons, **claim 13**, as well as **claims 14 and 15**, which depend therefrom is not anticipated and is not obvious in light of Nishii.

Claims 19 and 20 were included in the list of claims rejected under 35 U.S.C. 102(e) as being anticipated by Nishii. However, the Office Action provides no explanation for the rejection of **claims 19 and 20** under 35 U.S.C. 102(e). Accordingly, it is respectfully submitted that **claims 19 and 20** are not anticipated by Nishii, and withdrawal of the rejection of **claims 19 and 20** under 35 U.S.C. 102(e) is respectfully requested.

Claims 20 and 21 were rejected under 35 U.S.C. 102(b) as being anticipated by Motoyama.

However, in explaining the rejection of **claim 20**, the Office Action asserts that "Motoyama teaches of a blank page distinguish and detection system" and that this "reads on a printing system to automatically exclude unwanted blank pages of a job from a main job output screen." However, Motoyama distinguishes blank pages at the beginning of a job from blank pages within the middle of a reproduction job. Motoyama considers blank pages within the middle of a reproduction job to be "proper blank pages" (column 2, lines 1-15; lines 35-36). Motoyama does not exclude unwanted pages from a job. Instead, if Motoyama detects blank pages at the beginning of a job, Motoyama assumes that the job has been incorrectly placed in an automatic document feeder and aborts the entire job (column 2, lines 1-10). If Motoyama detects blank pages within the middle of a reproduction job, they are allowed to print normally (column 2, lines 7-10). Motoyama does not disclose or suggest unwanted non-blank pages.

Accordingly, for at least these reasons, Motoyama does not anticipate the subject matter of **claims 20 and 21**.

Additionally, in further explanation of the rejection of **claim 20**, the Office Action makes reference to the discussion of a black dot threshold and a black dot comparator in Motoyama and asserts that this disclosure reads on a means for describing one or more characteristics of a non-blank page that is unwanted. However, Motoyama does not disclose or suggest unwanted blank pages. Furthermore, that the system of Motoyama searches for blank pages by counting the number of black dots on a page does not disclose or suggest a means for describing (i.e., to a printing system) one or more characteristics of a non-blank page that is unwanted. Furthermore, even if the black dot threshold and the black dot comparator of Motoyama could be construed to be a means for describing one or more characteristics of a non-blank page that is unwanted (which is disputed). The black dot threshold and black dot comparator of Motoyama are not the means for describing one or more characteristics of a non-blank page disclosed in the present application.

In this regard, it is respectfully submitted that “an element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof and such claim shall be construed to cover the corresponding structure, material or acts described in the specification and equivalents thereof” (35 U.S.C. §112, sixth paragraph).

Accordingly, Motoyama does not anticipate **claims 20 and 21**.

The Office Action goes on to assert that Motoyama teaches that if the information page threshold is exceeded or not determines a blank page and asserts that this “reads on a means for searching within the main job input image data for portions of the job that have the described characteristics and locating a page of the main job input image data that has the described characteristics.” However, determining that a page is blank is very different than finding a page that matches described characteristics of a non-blank page. Nothing in the discussion found at column 8, lines 24-28, cited by the Office Action, which discusses the size of copying paper set by a set command and whether or not graphic data remains in a buffer, discloses or suggests a means for searching within main job input image

data for portions of the job that have the described characteristics of a non-blank page that is unwanted. Furthermore, nothing in the cited portion of column 10 discloses or suggests a means for locating a page of the main job input image data that has the described characteristics. Moreover, Motoyama does not disclose or suggest the means for searching and/or the means for locating described in the present application.

Motoyama is not concerned with deleting blank pages or non-blank pages from a main print job. Instead, Motoyama is concerned with determining whether or not a reproduction job has been incorrectly placed in an automatic document feeder (column 2, lines 1-10). With regard to the recitation of a means for locating a page of the main job input image data that has the described characteristic and means for deleting the located page from the main job input data to generate main job output data and means for delivering the output data to the output stream, the Office Action directs the attention of the Applicants to column 7, lines 15-20 and 53-63, as well as column 8, lines 24-45. However, the cited portions are unrelated to locating a page of the main job input image data that has the described characteristics of a non-blank unwanted portion or deleting the located page from the main job input data.

It is respectfully submitted that column 7, lines 15-20, merely explain that if the system detects a non-blank page (any non-blank page, not a non-blank page matching described characteristics), the system of Motoyama assumes that the reproduction job has been correctly placed in the automatic document feeder and, accordingly, deactivates the detection system (i.e., the blank page detection system) until a new reproduction job is started (column 7, lines 17-20).

Column 7, lines 53-66, simply explain that "to distinguish between an initial blank page and a blank page in the middle of a copy job, the controller **140** uses the OVERRIDE signal **141**. The OVERRIDE signal goes low ("0") every time a new print job comes into the detection system **118**. The information page comparator **150** generates a high OVERRIDE signal **141** whenever a non-blank page is detected. Once the OVERRIDE signal **141** has been activated, the controller **140** will prevent the detection system **118** from detecting any further blank pages until a new reproduction job is started. Thus, the detection system **118** is activated at the beginning of every print job and then turned off by the controller **140** once an image page is scanned. In summary, a reproduction job is only stopped if the OVERRIDE

signal **141** is low and the blank page counter exceeds the blank page threshold. This system allows the reproduction machine to distinguish between initial blank copy pages and blank pages within a reproduction job which will not stop the reproduction job."

Nothing in this text discloses or suggests searching for described characteristics of a non-blank page or removing data related to a non-blank page.

Page 8, lines 24-45, describe the incrementing of a blank page counter and the determination as to whether the value of the blank page counter exceeds a blank page threshold. If the blank page counter exceeds the blank page threshold, **which may indicate that the reproduction job is upside down in the automatic document feeder**, then the job is stopped. This feature allegedly allows the system method of Motoyama to distinguish between initial blank pages within a reproduction job and blank pages later in a job that should not stop a reproduction job (column 8, lines 43-45).

It is respectfully submitted that nothing in the cited portion of column 8 discloses or suggests searching for or locating a non-blank page having described characteristics or deleting a located non-blank page having the described characteristics from the main job input data or means for doing so. Moreover, Motoyama does not disclose or suggest the means for doing so described in the present application.

For at least the foregoing reasons, **claim 20**, as well as **claim 21**, which depends therefrom, is not anticipated by Motoyama.

Claim 21 recites means for describing text included on the unwanted non-blank page. Motoyama does not disclose or suggest a means for describing text included on an unwanted non-blank page. Motoyama does not disclose or suggest unwanted pages. Furthermore, Motoyama does not disclose or suggest unwanted non-blank pages. Moreover, Motoyama does not disclose or suggest describing text included in an unwanted non-blank page.

Column 2, lines 38-40, cited by the Office Action, are part of a summary of a method for distinguishing between initial blank pages and subsequent blank pages within a job for a reproduction machine that has steps of selectively generating a detect signal, scanning a page to generate digital page data, and comparing the digital page data to a black spot threshold. Nothing in column 2, lines 38-40,

discloses or suggests a means for describing text or a means for describing text included on an unwanted non-blank page.

Column 5, lines 64-67, indicate that "the IMAGEDATA signal 126 contains electrical signals representing the optical characteristics of a page that are used by the detection system 118 to detect and distinguish blank pages in a reproduction job. Nothing in the cited portion of column 5 discloses or suggests describing text or a means for describing text. Moreover, nothing in the cited portion of column 5 discloses or suggests a means for describing text included on an unwanted non-blank page.

Column 6, lines 44-50, indicate that "the black dot comparator 142 compares each dot within the IMAGEDATA signal 126 to a black dot threshold signal contained within a black dot threshold memory 146. The black dot comparator 142 determines if a black dot is present. The black dot threshold signal, which is generated by the reproduction machine at startup, varies depending on temperature of the scanning lamp and is stored in the black dot threshold memory 146." It is respectfully submitted that nothing in the cited portion of column 6 discloses or suggests describing text or describing text included on an unwanted non-blank page. Furthermore, nothing in the cited portion of column 6 discloses or suggests a means for describing text included on the unwanted non-blank page.

Even if Motoyama could be construed as disclosing some means for describing text included on an unwanted non-blank page, Motoyama does not disclose or suggest the means for describing text included on the unwanted non-blank page disclosed in the present application.

For at least the foregoing additional reasons, **claim 21** is not anticipated by Motoyama.

The Claims are not Obvious

Claims 2 and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nishii in view of Nakajima Toru.

Claim 2 depends from **claim 1** and is patentably distinct for at least that reason. Additionally, **claim 2** recites notifying an operator in response to detecting data representative of the characteristic (i.e., the characteristic of an unwanted page). The Office Action stipulates that Nishii fails to disclose notifying an operator

of such detected data and relies on Nakajima Toru for this disclosure. However, Nakajima Toru does not disclose or suggest notifying the user of detecting data representative of the characteristic of an unwanted page to be removed from an output stream. Instead, it is respectfully submitted Nakajima Toru notifies the operator of some problem with the input image data (i.e., invalid). For example, pages to be scanned may have been placed in the scanner upside down or a brightness or contrast setting may not be set properly (e.g., see paragraph 13).

For at least the foregoing reasons, **claim 2** is not obvious in light of Nishii and Nakajima Toru taken alone or in any combination.

Claim 11 recites a method operative to semi-automatically exclude unwanted portions of a main job from a main job output stream of a printing system including *inter alia*: accepting one of an authorization and prohibition from an operator to remove a potentially unwanted portion, determining that the potentially unwanted portion is an unwanted portion if the authorization is accepted and removing the unwanted portion from the main job input stream, thereby excluding the unwanted portion from the main job output stream.

In this regard, arguments similar to those submitted in support of **claims 1, 12 and 13** are submitted in support of **claim 11**. Additionally, the Office Action stipulates that Nishii fails to disclose notifying an operator that an unwanted portion has been located and relies on Nakajima Toru for such disclosure. However, Nakajima Toru does not notify an operator that an unwanted portion has been located. Instead, Nakajima Toru notifies a user of invalid data in an input stream thereby allowing a “user to perform adjustment of reading sensibility, etc.”, and reads again (paragraph 13).

For at least the foregoing reasons, **claim 11** is not obvious in light of Nishii and Nakajima Toru taken alone or in any combination. Additionally, it is respectfully submitted that the Office Action has not met its burden for presenting a case of *prima facie* obviousness.

It is respectfully submitted that the motivation for combining Nishii and Nakajima Toru suggested by the Office Action is specious. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (MPEP 2143.01(III)). Nishii does not disclose or suggest that a user could or should be

notified when a characteristic is detected. Nakajima Toru notifies an operator that invalid data has been detected so that pages can be reoriented and rescanned or so that sensitivities can be adjusted and pages rescanned (paragraph 13). Nishii and Nakajima Toru do not disclose or suggest notifying a user that a characteristic of an unwanted page or document portion has been detected so that the user or operator can authorize or prohibit the removal of that portion from input image data, thereby removing it from an output stream.

Furthermore, it is respectfully submitted that any motivation to make the combination of Nishii and Nakajima Toru could only have been found in the present application. Therefore, the rejection of **claims 2 and 11** is based on impermissible hindsight and, for this additional reason, the Office Action has not met its burden for presenting a case of *prima facie* obviousness.

Claims 9 and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nishii in view of Motoyama. However, even if the assertions of the Office Action with regard to the disclosure of Nishii are correct, **Motoyama teaches away** from removing blank pages from within the middle of a reproduction job by declaring that it is an objective of Motoyama to provide a system that permits a blank page within the middle of a reproduction job to print normally (column 2, lines 1-10). Since Motoyama teaches away from removing blank pages, one of ordinary skill in the art would not look to Motoyama to solve the problem of unwanted pages. Therefore, it would not be obvious to combine disclosure of Motoyama with any other document to solve the problem of unwanted pages. For at least the foregoing reason, **claims 9 and 19** are not anticipated and are not obvious in light of Nishii and Motoyama taken alone or in any combination.

Additionally, **claims 9 and 19** depend from **claims 12 and 13**, respectively, and are patentably distinct for at least those reasons.

Furthermore, **claim 9** recites searching within input image data comprises using pattern recognition techniques to search for matching characteristics. The Office Action stipulates that Nishii fails to disclose searching within an input image data comprises using pattern recognition techniques and relies on Motoyama for this disclosure. Additionally, the Office Action asserts that the Applicant is correct in asserting that Motoyama does not recognize patterns (section 6, page 3, of the Office Action).

For at least the foregoing reasons, **claim 9** is not anticipated and is not obvious in light of Nishii and Motoyama taken alone or in any combination.

Additionally, it is respectfully submitted that the Office Action does not meet its burden for presenting its case of *prima facie* obviousness. The Office Action asserts that Nishii could have easily been modified to scan a page and compare a digital page data to a black spot threshold of Motoyama. However, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (MPEP 2143.01(III)). It is respectfully submitted that there is no motivation in the art to modify Nishii according to the black spot threshold of Motoyama other than some motivation that might be provided by the present application. Therefore, the rejection of **claim 9** can only be based on impermissible hindsight.

Telephone Interview

In the interests of advancing this application to issue, the Applicants respectfully request that the Examiner telephone the undersigned to discuss the foregoing or any suggestions that the Examiner may have to place the case in condition for allowance.


CONCLUSION

Claims 1-3, 7, 9, 11-15, 18-21 remain in the application. **Claims 1, 7, 11 and 12** have been amended to correct antecedence or improve consistency. Accordingly, entry of this amendment, if only to place the claims in better condition for appeal is respectfully requested. For at least the foregoing reasons, the application is in condition for allowance. Accordingly, an early indication thereof is respectfully requested.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

September 26, 2006
Date



John P. Cornely, Reg. No. 41,687
Thomas Tillander, Reg. No. 47,334
1100 Superior Avenue, 7th Floor
Cleveland, Ohio 44114-2579
(216) 861-5582

N:\XERZ\200378\IEW0004872V001.doc